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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,697	04/17/2001	Sylvain Chevreau	PF980072	2501

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,697

Applicant(s)

CHEVREAU ET AL.

Examiner

Bradley B. Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 7, 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 April 2005 has been entered.

Status of Claims

Applicant has amended claims 1, 7 and 10 in the response filed on April 4, 2005. Thus, claims 1-12 remain pending and are presented for examination on the merits.

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claims 7 is objected to because of the following informality: Applicant recites "A method of copying onto a medium..." without disclosing the nature of what is being copied onto the medium in the preamble of claim 7. For instance, the applicant may add the terms "digital data" after "copying" to indicate the nature and purpose of the claimed subject matter.

Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

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claim(s) in independent form. The claim merely recites non-functional descriptive material that fails to further limit the subject matter recited in claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Akiyama et al. (US 5,805,699, hereinafter Akiyama).

As per claim 1, Akiyama discloses a method of copying digital data from a source of digital data onto a medium, said method comprising the steps of:

- formatting the digital data from said source of digital data using a function based on at least a serial number contained in said medium, to thereby prevent bit by bit duplication of the digital data onto another medium (column 3, lines 47-50, target storage medium identifier); and
- recording said formatted data onto said medium (column 3, lines 65-67).

As per claim 2, Akiyama discloses the method of claim 1, wherein the serial number is recorded on the medium during manufacture of the medium (column 4, lines 6-8).

As per claim 3, Akiyama discloses the method of claim 1, wherein the serial number is a unique number for each medium (column 3, lines 48-50).

As per claim 4, Akiyama discloses the method of claim 1, wherein the step of formatting of the digital data to be duplicated is carried out using a secret-key encryption algorithm or a public-key algorithm (column 6, lines 1-6).

As per claim 5, Akiyama discloses the method of claim 4, wherein the encryption algorithm uses an encryption key that is dependent on the serial number (column 6, lines 39-61; figure 5, IDk storage medium identifier).

As per claim 6, Akiyama discloses the method of claim 5, wherein the encryption key is furthermore dependent on a secret parameter contained in a reading device adapted for reading the digital data arising from said source (column 7, lines 8-23).

As per claim 7, Akiyama discloses a method of copying onto a medium, wherein the medium comprises a serial number the method comprising the following steps:

- sending of the serial number recorded on the medium to the reading device (figure 2, step S1; IDk sent to central site),

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- formatting of the digital data read with the aid of the serial number, to thereby prevent bit by bit duplication of the digital data onto another medium (figure 2, steps S2, S3; column 4, lines 57-65), and
- recording on said medium the formatted digital data (figure 2, step S7).

As per claim 8, Akiyama discloses the method of claim 7, wherein the formatting step is carried out in the reading device (figure 2, step S4; another certificate code is generated locally at the end user).

As per claim 9, Akiyama discloses the method of claim 7, wherein the reading device comprises means for reading the medium containing the formatted digital data (figure 2, step S5, the locally generated certificate is read and compared with the other certificate).

As per claim 10, Akiyama discloses the method of claim 7, further comprising before performing the duplication of the digital data, a step of checking authorization to copy (figure 2, step S6; if comparison of certificates is verified, allows for duplication of data in S7).

As per claim 11, Akiyama discloses a reading device allowing the implementation of a method of copying according to claim 1, wherein it comprises a formatting circuit adapted for receiving the serial number of the medium onto which the digital data are to be copied and providing as output, formatted data which are dependent on said serial number and are intended to be copied onto said medium (figure 1 and associated text).

As per claim 12, Akiyama discloses a recording medium for digital data comprising a serial number which is unique or exhibits a low probability of being common with that of another medium, wherein it furthermore comprises recorded digital data, said digital data being formatted as a function of said serial number and of a secret parameter (figures 1 and 2 and associated text; column 7, lines 8-23).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6,842,521 B2 to Nakamura for a Method and Apparatus to Control Coping from a Drive Device to a Data Reproducing Device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8am-6: 30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Bradley B. Bayat', with a stylized horizontal line extending from the end of the signature.

Bradley B. Bayat
Patent Examiner
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